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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,311

09/27/2006

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EXAMINER

EVANS, FANNIE L

ART UNIT

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2877

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,311	Applicant(s) KAWANO ET AL.	
	Examiner F. L. Evans	Art Unit 2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24 and 25 is/are allowed.
- 6) ☒ Claim(s) 1,20 and 21 is/are rejected.
- 7) ☒ Claim(s) 2-19, 22, 23 and 26-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>122706,120507</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. § 119(a)-(d), which papers have been placed of record in the file.

The Information Disclosure Statements

The prior art cited in the information disclosure statements filed on December 27, 2006 and December 5, 2007 has been considered.

The Specification

The abstract is too long. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claims 10, 13-19 and 26 are objected to because of the following informalities.

The lack of an antecedent for “the optical-path-length adjustment unit” in line 2 of claim 10; “the zooming mechanism” in line 2 of claim 13, lines 3 and 6 of claim 14, lines 2 and 6 of claim 17; and “the processing unit” bridging lines 1 and 2 of claim 26 renders these claims and any claim dependent therefrom indefinite.

In line 4 of claim 15, at least two support stands are set forth. Lines 3, 4 and 5 of dependent claim 17 refer to “the support stand”. Which of the at least two support stands of claim 15 is referenced in lines 3-5 of claim 15?

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Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 20 and 21 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Suzuki et al (US 2002/0176160 A1)

Suzuki et al disclose an examination apparatus (10) comprising: a light source (13) for emitting excitation light or illumination light to a specimen placed on a stage (12); an objective lens (31,32) opposing the stage and **capable of** focusing fluorescence or reflected light from the specimen; an image-forming lens (34,35) for forming an image of the specimen obtained by the objective lens; and an image-capturing unit (20) for capturing the image of the specimen forming by the image-forming lens, wherein a plurality of the objective lenses (31,32) having different magnifying powers is provided, and an objective-lens switching mechanism (paragraphs [0128] and [0129]) for switching among the objective lenses is provided, and wherein a plurality of the image-forming lenses (34, 35) having different magnifying powers is provided, and an image-forming-lens switching mechanism (paragraphs [0130] and [0131]) for switching among the image-forming lenses is provided. Suzuki et al disclose a transparent tray member (11 - slide with specimen) capable of being fixed to the stage while being positioned, the tray member fixing the specimen.

Additional Prior Art

Ogino et al (US 2002/0060842) and Ogino (JP 2003-5079) disclose an examination apparatus comprising: a light source for emitting excitation light or illumination light to a specimen placed on a stage; an objective lens opposing the stage and capable of focusing fluorescence or reflected light from

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the specimen; an image-forming lens for forming an image of the specimen obtained by the objective lens; and an image-capturing unit for capturing the image of the specimen forming by the image-forming lens, wherein a plurality of the objective lenses having different magnifying powers is provided, and an objective-lens switching mechanism for switching among the objective lenses is provided, and wherein a plurality of the image-forming lenses having different magnifying powers is provided, and an image-forming-lens switching mechanism for switching among the image-forming lenses is provided. See Figs. 3, 9 and 11 of Ogino et al and Fig. 3 of Ogino.

Allowable Subject Matter

Claims 24 and 25 are allowed over the prior art of record.

Claims 2-9, 11, 12, 22, 23 and 27-31 are objected to as being dependent upon a rejected base claim, but would be allowable if claims 2, 3, 6, 8, 9, 12, 22, 23 and 27 were rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10, 13-19 and 26 would be allowable if rewritten to overcome the objection set forth in this Office action and if claims 13 and 14 were rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

As to dependent claims 2, 3, 6, 8, 9, 12, 13, 14, 22, 23 and 27, the prior art of record, taken alone or in combination, fails to disclose or render obvious an examination device comprising the limitation set forth in the body of these claims, in combination with the rest of the limitations of independent claim 1.

As to independent claim 24, the prior art of record, taken alone or in combination, fails to disclose or render obvious a fluoroscopy apparatus comprising a plurality of lens groups, each group including an objective lens for magnifying fluorescence from the specimen, the objective lens opposing the stage, and an image-forming lens for imaging the fluorescence from the specimen magnified by the objective lens;

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and a lens-group-switching mechanism for switching among the lens groups, in combination with the rest of the limitations of the claim.

Fax/Telephone Numbers

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner whose telephone number is (571) 272-2414.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr. can be reached on (571) 272-2800 ext 77. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/F. L. Evans/
Primary Examiner
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August 12, 2008